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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,790	12/24/2003	Masanao Yamagishi	2003_1869A	9812
513	7590	01/04/2006	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P.			PICKETT, JOHN G	
2033 K STREET N. W.			ART UNIT	
SUITE 800			PAPER NUMBER	
WASHINGTON, DC 20006-1021			3728	

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

Application No.

10/743.790

**Applicant(s)**

YAMAGISHI ET AL.

Examiner

**Gregory Pickett**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8,9,12 and 13 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8,9,12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

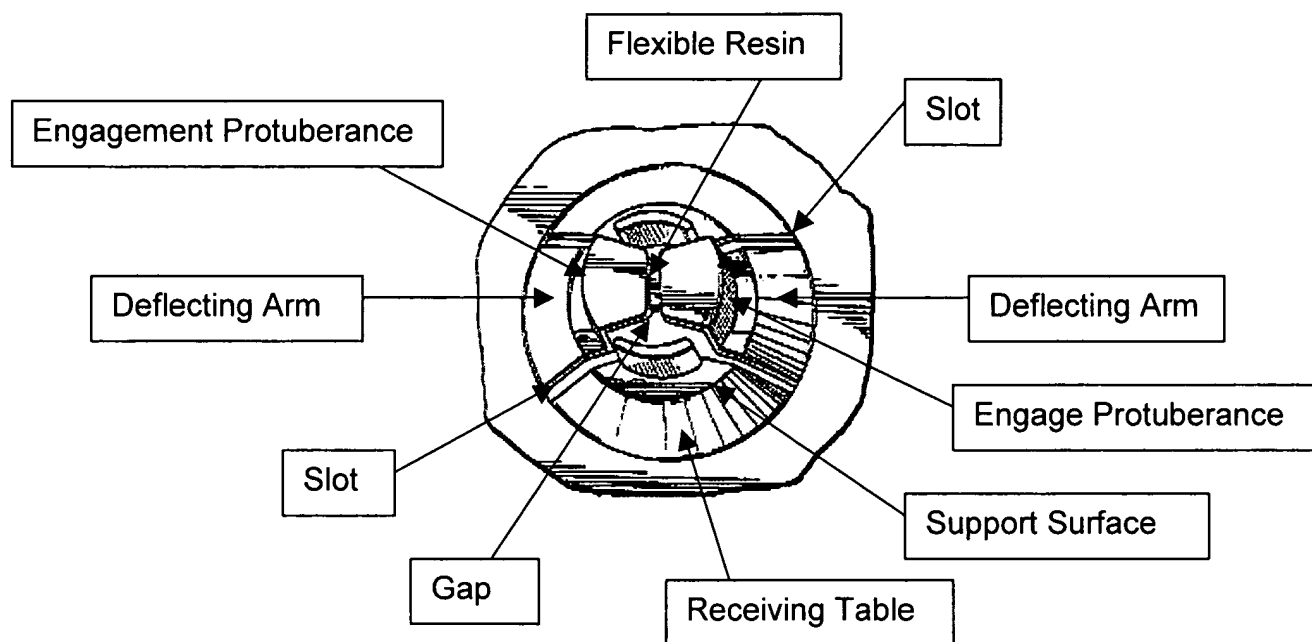
1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 September 2005 has been entered. Claims 8, 9, 12, and 13 are pending in the application. Claims 1-7, 10, and 11 have been canceled.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

3. Claims 8, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsilio et al (US 2002/0170838 A1) in view of Lopez Mas (D470,707) and Wong (US 6,085,900).

Regarding claim 8, Marsilio et al discloses a disk case **10** with a main body **12**, cover **14**, connection portion **16**, outer peripheral edge **42**, and notches **50**. The central hub of Marsilio et al lacks a gap between deflectable arms.

Lopez Mas discloses a central hub as shown below (see for example, Figure 7):



Lopez Mas shows that a hub with a gap between deflectable arms was an equivalent structure known in the art. Therefore, because these two disk-retaining means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the hub of Lopez Mas for the hub of Marsilio et al. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

As to the material, Marsilio-Lopez Mas discloses the claimed invention except for the express disclosure of a flexible resin material. It would have been an obvious matter of design choice to one of ordinary skill in the art at the time the invention was made to form the case from a flexible resin, since it has been held to be within the

general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Marsilio-Lopez Mas discloses the claimed invention except for the upwardly extending engagement pawls cut-off from the engagement protuberances.

Wong discloses upwardly extending engagement pawls **28** cut-off from the engagement protuberance **26** by means of slot **29** and are used to secure the retained disk against vertical movement (Col. 4, lines 33-40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Marsilio-Lopez Mas with upwardly extending engagement pawls cut-off from the engagement protuberances as taught by Wong in order to secure the retained disk against vertical movement.

As to claim 12, the gap of Lopez Mas is disposed as claimed.

As to claim 13, the hub of Marsilio et al is located on surface **40** and it would have been obvious to place the substitute hub of Lopez Mas in the same location in order to keep the disk centrally located.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marsilio-Lopez Mas-Wong as applied to claim 8 above, and further in view of Flores, Jr. et al (US 2003/0015443 A1).

Marsilio-Lopez Mas-Wong, as applied to claim 8, discloses the claimed invention except for the cut-off portion and fall-off prevention pawl.

Flores discloses a cut-off portion (see Figure 6) and fall-off prevention pawl 140 used to secure the disk in the storage area (see paragraph [0054]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Marsilio-Lopez Mas-Wong with a cut-off portion and fall-off prevention pawl as taught by Flores in order to secure the disk in the storage area.

### ***Response to Arguments***

5. Applicant's arguments filed 28 September 2005 have been fully considered but they are not persuasive.
6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
7. In response to applicant's argument that Wong teaches the engagement pawls formed as part of a rigid central core, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*,

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642 F.2d 413, 208 USPQ 871 (CCPA 1981). Wong specifically teaches the pawls for restriction of vertical movement (Col. 4, lines 33-45) and part of the central core. The central core of Lopez Mas consists of the engagement protuberances (see above).


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Greg Pickett  
Examiner  
29 December 2005

  
David T. Fidei  
Primary Examiner